

**REMARKS**

Claims 1-9 are pending. Claims 1 and 3 were amended to more particularly point out and distinctly claim the present invention. Claim 9 was added to further define the present invention. No new matter was added. The new language in claims 1 and 3 is supported by at least page 7, lines 19-20 of the specification and Figs. 2A-2B and 3A-3C. Claim 9 is supported by at least Figs. 2A-2B and 3A-3C.

**Examiner Interview**

Applicant wishes to thank Examiner Lett and Examiner King Poon for extending the courtesy of a personal interview with the undersigned representative and inventor Mark Weiss on April 5, 2007. During the interview, items on a previously faxed Agenda were discussed.

The Examiner accurately summarized the substance of the interview on the "Interview Summary" form dated April 5, 2007. Accordingly, no independent summary is provided.

**35 U.S.C. § 102(b) rejection**

Claims 1-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,967,050 (Seymour). Applicants respectfully traverse this rejection.

During the personal interview, the Examiner agreed that claims 1-8 patentably distinguish over Seymour. Accordingly, no further comments regarding this rejection is provided.

**35 U.S.C. § 101 rejection**

**1. New arguments/discussion**

In the outstanding Office Action, the Examiner responded to Applicant's arguments as follows:

With respect to the arguments directed to *In re Gulack*, the Examiner stated that Gulack is not relevant because Gulack was based on a 103 prior art rejection, not a 101 non-statutory rejection.

With respect to the remaining arguments, the Examiner asked Applicant to review MPEP 706.03(a) which reads as follows:

MPEP 706.03(a)

A. Printed Matter

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). (underlining in the Examiner's Office Action)

Applicant traverses this rejection because the claimed invention is not a mere arrangement of printed matter. Applicant provides the following discussion of the above-identified case law cited in the MPEP. It is Applicant's understanding that the MPEP case law is the USPTO's attempt to define the types of issues that arise in "printed matter" rejections and to indicate the types of inventions that are and are not non-statutory under § 101.<sup>1</sup>

a. ***In re Jones***: Applicant's claimed color bars are "structure" analogous to the pattern areas in *Jones*. *Jones* provides the following instructions on how to distinguish between non-statutory printed matter and printing on a surface.

That claim, and the others likewise, do not, in our opinion, define "printed matter" in the sense in which that term has heretofore been used to indicate various sorts of indicia whose primary purpose is the conveying of intelligence to a reader. What we find on the disk we would not characterize as indicia or printing but as structure, albeit the "pattern areas" of claim 1 are not necessarily transparent and opaque, respectively, and might be produced by some sort of printing technique.  
*In re Jones*, 153 USPQ 77 at 80-81 (underlining added for emphasis)

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<sup>1</sup> Two of the three cited cases resulted in a reversal of the § 101 rejection. However, all of the cases analyze key issues for deciding whether presented claims are statutory.

Certainly there is no “printing” in this case in the form of words or other symbols intended to convey intelligence to a reader nor in the form of rulings as on a business form. *Jones* at 81 (underlining added for emphasis)

Like *Jones*, Applicant’s claimed color bars do not convey intelligence to a reader in the form of words or other symbols nor in the form of rulings as on a business form. Also, like *Jones*, Applicant’s claimed color bars are structure, even though they might be produced by some sort of printing technique.

b. ***In re Miller***: Regarding claim 1, Applicant’s claimed color bars define a new and unobvious functional relationship between color bar indicia pre-printed on one region of proofing paper in relation to another region of the proofing paper. Regarding claim 3, Applicant’s claimed color bars define a new and unobvious functional relationship between one or more standard first color bars pre-printed on proofing paper and the one or more second color bars that are printed in a predefined relationship to the one or more first color bars. As stated in *In re Miller*, new and unobvious functional relationships define patentable subject matter:

Here there is a new and unobvious functional relationship between a measuring *receptacle*, volumetric *indicia* thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio, and in our judgment the appealed claims properly define this relationship. *In re Miller*, 164 USPQ 46 at 49 (underlining added for emphasis)

c. ***Ex parte Gwinn***: This case is not relevant to the present invention because the analysis in *Gwinn* was based on a comparison of the claims to prior art references. The Examiner stated on page 2 of the Final Rejection that the principles of *In re Gulack* cited by Applicant are not relevant because “the decision in *Gulack* is based on a 103 prior art rejection, not a 101 non-statutory rejection.” The same reasoning thus applies to *Gwinn*.

Also, *Gwinn* is clearly distinguishable from the presently claimed invention because in *Gwinn*, the dots on the dice are “symbols intended to convey intelligence” (see quotation from *In re Jones* above), whereas Applicant’s claimed color bars are “structure” analogous to the pattern areas in *Jones*.

2. Arguments/discussion repeated from previous Amendment filed November 2, 2006:

The Examiner asserts that “[d]ata that is preprinted in certain regions of a page is merely text or image(s), and the combination does not impart functionality. The paper and data combination does not result in a useful, concrete and tangible result.” Applicant respectfully traverses this rejection.

Claim 3 recites a hard proof that can be visually inspected to discern color match/mismatch, thereby determining if the hard proof meets industry standards. Claim 3 recites the elements of the hard proof that allows for the visual inspection, namely, (1) the one or more first color bars, and (2) the one or more second color bars printed in a predefined relationship to the one or more first color bars.

The ability to perform visual inspection to discern color match/mismatch is a useful, concrete and tangible result. Furthermore, the ability to do so without using any external color reference materials is a significant advancement over the prior art and provides clear “real world” value and functionality. Thus, the explicitly claimed elements in claim 3 are exactly the elements that provide a useful, concrete and tangible result, namely, a hard proof that can be visually inspected.

The fact that these elements are data preprinted in certain regions of a page does not in any way detract from the fact that the preprinted data itself provides a useful, concrete and tangible result, here, visual inspection of the hard proof for color matching/mismatching without using any external color reference materials. Many types of data preprinted on a page are potentially patentable. For example, optical scan forms that contain markings arranged in a particular manner to allow for improved registration provide a useful, concrete and tangible result, and thus are potentially patentable, even though the markings are just preprinted data on certain regions of a page. Furthermore, Class 283 (Printed Matter) is entirely devoted to inventions related to the arrangement of preprinted data (indicia) on paper. Thousands of U.S. patents have been issued to a specific arrangement of markings on a preprinted form. The hard proof of claim 3, likewise, contains markings (i.e., color bars) that provide improved functionality.

Claim 1 recites proofing paper comprising a specific combination of regions, namely, a blank region for subsequent printing of a content image portion, and a second region outside of the first blank region having one or more standard color bars pre-printed thereon. This specific combination of regions likewise provides a useful, concrete and tangible result. In the prior art, proofing paper is either completely blank (i.e., no indicia at all is printed anywhere on the proofing paper) or it contains a content image portion, either with or without a color bar printed thereon. Applicant's invention provides a novel and unobvious alternative option, namely proofing paper that has a blank content image portion, but with one or more standard color bars pre-printed thereon. A useful, concrete and tangible result is provided by this type of proofing paper because it allows for the proofing paper to be visually inspected for color matching/mismatching as discussed above when the proofing paper is subsequently printed with the content image portion and a second bar code having a predefined relationship with the pre-printed bar code. Claim 1 thus provides clear "real world" value and functionality.

Annex IV of the USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility"<sup>2</sup> discusses "printed matter" as follows:

The USPTO must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). The USPTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10. However, the examiner need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

Here, Applicant has clearly demonstrated that the claimed "printed matter" a new and unobvious functional relationship between the printed matter and the substrate.

Notwithstanding the arguments above, claims 1 and 3 were amended to recite that:

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<sup>2</sup> OG Notice: November 22, 2005.

each of the one or more standard color bars hav[e] a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space

These limitations further distinguish the claimed invention from being a mere arrangement of printed matter. Specifically, these limitations add even further “structure” analogous to the pattern areas in *Jones*. Furthermore, the color blocks that reflect wavelengths are clearly not analogous to words or other symbols intended to convey intelligence to a reader that were found to constitute “printed matter” in *Jones*.

Reconsideration of the § 101 rejection of claims 1 and 3 is respectfully requested in view of the arguments above.

#### **Patentability of new claim 9 in view of § 101**

New claim 9 reads as follows:

9. The proofing paper of claim 1 wherein the first blank region and the second region constitute the entire surface area of one side of the proofing paper.

This claim clearly recites structure and functional relationships, and cannot be characterized as “mere printed matter.”

#### **Conclusion**

Insofar as the Examiner’s rejections were fully addressed, the instant application is in condition for allowance. Issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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